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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,383	08/01/2001	Shunsuke Yajima	70904-56304	4400
21874	7590	11/17/2006	EXAMINER	
EDWARDS & ANGELL, LLP			JOO, JOSHUA	
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BOSTON, MA 02205			PAPER NUMBER	
			2154	

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,383

Applicant(s)

YAJIMA ET AL.

Examiner

Joshua Joo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 7,9,11,13,15,17,19,21,23,25,27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,10,12,14,16,18,20,22,24 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/16/06, 8/21/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Detailed Action

1. Claims 1-28 are presented for examination.

Claims 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, and 27-28 are withdrawn from consideration.

Response to Arguments

2. Applicant's arguments with respect to claims 1-6, 8, 10, 12, 14, 16, 18, 20, 22, 24, and 26 have been considered but are moot in view of the new ground(s) of rejection. Applicant argued that:

3. (1) Mazzagatte does not teach, disclose, or suggest the storage of identification data that uniquely identifies operation data in the smart card (Remarks filed 8/21/2006). By identifying an intended recipient, the Mazzagatte identification information non-uniquely identifies the intended recipient of a particular print job with that recipient because any/all print jobs that are/is intended for that recipient are identified by the Mazzagatte identification information (Remarks filed 4/14/2006).

4. In response, Mazzagatte teaches of a smart card containing unique identification data of a recipient (Col 9, lines 52-55). The identification data of the recipient is compared to identification information stored in the print queue and is used to determine print jobs intended for the recipient (Col 10, lines 15-20). Thus, the identification data uniquely identifies an operation data, i.e. print job, of the recipient, from operation data, i.e. print job, of other recipients in the printer queue.

The features of identifying a particular print job or any/all print jobs, which Applicant argued that Mazzagatte does not teach, are not defined in the claims. The claims merely recited of identification data that uniquely identifies operation data. Examiner respectfully notes that these features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted 8/16/2006, 8/21/2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 8, 10, 12, 14, 16, 18, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte, US Patent #6,862,583 (Mazzagatte hereinafter), in view of Francis et al, US Patent #6,650,430 (Francis hereinafter).

8. As per claims 1 and 22, Mazzagatte teaches substantially the invention as claimed including the method and system for generating print data and identification data, where printing is based on matching of identification information, Mazzagatte's teachings comprising:

data preparation means for preparing operation data and identification data that uniquely identifies the operation data (Col 7, lines 46-48; Col 8, lines 19-23. Submits print data and identification information.);

an electronic device which carries out processing based on the operation data prepared by said data preparation means (Col 9, lines 61-62. Printer prints data.); and

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said portable data storage means including identification data storage means for storing the identification data (Col 8, lines 35-38. Smart card contains identification information. Col 5, lines 23-25. Write to smart card.),

wherein said portable data storage means transmits automatically the identification data stored in said identification data storage means to said electronic device when said portable data storage means approaches said electronic device (Col 9, lines 56-59. Upon presenting the smart-card to the printer, printer first verifies the unique identification information.), and when said electronic device receives the identification data from said portable data storage means (Col 9, lines 56-59. Printer verifies information smart card.), said electronic device carries out the processing based on the operation data uniquely identified by the identification data (Col 9, lines 61-62; Col 10, lines 15-19. Printer identifies print jobs based on the identification data of the smart card and proceeds with printout process.).

9. Mazzagatte teaches substantial features of the claimed invention including using identification data corresponding to the print job (Claim 1; Col 8, lines 19-23); a smart-card interface device to write to the smart card (Col 5, lines 23-25); and linking identification information on the smart card with the print job (Col 9, lines 57-58). However, Mazzagatte does not specifically teach of receiving identification data from a data preparation device.

10. Francis teaches of entering information into the memory of a smart card (Col 3, lines 40-52) and transmitting the information to the printer (Col 7, lines 37-40).

11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte and Francis because both teachings deal with providing secure printing by using smart cards that contain identification information. Furthermore, the teachings of Francis to enter the identification information into the smart card would improve the teachings of

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Mazzagatte by specifying how the smart card contains the identification information, and allowing for updates to the identification information on the smart card.

12. As per claim 24, Mazzagatte teaches substantially the invention as claimed including the method and apparatus for generating print data and identification data, where printing is based on matching of identification information, Mazzagatte's teachings comprising:

a data preparation section for preparing operation data to control the operation of an electronic device and identification data that uniquely identifies the operation data (Col 8, lines 20-24. Print job and identification information. Col 7, lines 45-47. Computer.);

an operation data transmitting section for transmitting the operation data prepared by said data preparation section to said electronic device (Col 8, lines 20-22, 59-61. Transmits print job along with identification information to the printer.);

a portable data storage device which stores the received identification data and automatically transmits the stored identification data to said electronic device when said portable data storage means approaches said electronic device (Col 9, lines 51-59. Smart-card contains unique identification information. Upon presenting the smart-card to the printer, printer reads the unique identification information on the smart-card.),

wherein said electronic device, upon receipt of the identification data from said portable data storage device, performs an operation based on the operation data uniquely identified by the received identification data, selected from among a plurality of operation data received from said operation data transmitting section (Col 9, lines 61-62; Col 10, lines 15-19. Printer identifies print jobs based on the identification data of the smart card and proceeds with printout process.).

13. Mazzagatte teaches substantial features of the claimed invention including identification data corresponding to the print job (Claim 1; Col 8, lines 19-23; being able to write on to the smart card (Col

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5, lines 23-25); and being able to write on to the smart card (Col 5, lines 23-25) and linking identification information with the print job (Col 9, lines 57-58). However, Mazzagatte does not specifically teach of a receiving section for receiving identification data from a data preparation device.

14. Francis teaches of providing secure printing, where the computer enters identification information into the memory of the smart card (Col 3, lines 50-52). The smart card transmits information from the smart card to the printer (Col 7, lines 36-39), where the smart card can be a contactless smart card or a RF identification card (Col 3, lines 59-64).

15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte and Francis because both teachings deal with providing secure printing by using smart cards that contain identification information. Furthermore, the teachings of Francis to input information to the smart card and to transmit information to the printer would improve the teachings of Mazzagatte by specifying how the smart card contains the identification information, and allowing for updates to the identification information on the smart card.

16. As per claim 2, Mazzagatte teaches the electronic device control system of claim 1, further comprising: transmitting means for transmitting the operation data prepared by said data preparation means to said electronic device (Col 8, lines 59-63. Sender submits print job and is transmitted to the printer.).

17. As per claim 3, Mazzagatte teaches the electronic device control system of claim 2 wherein: said transmitting means is a network, which connects at least one data preparation means and at least one electronic device (Fig 1. #100).

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18. As per claim 4, Mazzagatte does not specifically teach the electronic device control system of claim 1, wherein: said portable data storage means receives the identification data from said data preparation means and transmits the identification data to said electronic device by wireless. Francis teaches of inputting identification information into the memory of a smart card, wherein the smart card can be a contactless smart card or a RF identification card (Col 3, lines 59-64). Francis also teaches of transmitting information from the smart card to the printer (Col 7, lines 18-20, 36-39).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte and Francis because the teachings of Francis to provide a contactless card and to transmit information to the printer would further improve the system of Mazzagatte and Francis by allowing a client to conveniently print data without having the smart card come in contact with the printer, and allowing the printer to receive the information to verify the identification information.

20. As per claim 5, Mazzagatte teaches the electronic device control system of claim 1, wherein: said electronic device includes operation data storage means for storing the operation data transmitted from said data preparation means (Col 9, lines 8-10. Printer stores print data.); and said electronic device checks the operation data stored in said operation data storage means against the identification data received from said portable data storage means when receiving the identification data (Col 9, line 56-58. Printer verifies the identification information from smart card.), detects the operation data corresponding to the received identification data (Col 10, lines 14-18. Compares information from smart card with identification stored in print queue.), and carries out the processing based on the operation data (Col 10, line 20. Printout process.).

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21. As per claim 6, Mazzagatte teaches the electronic device control system of claim 3 further comprising: operation data management means (Col 6, line 62. Server), connected to said network, for storing the operation data prepared by said data preparation means and for managing a data output process to output the operation data to said electronic device (Col 6, lines 62-65. Server queues print data and sends data to a printer.).

22. As per claim 8, Mazzagatte teaches the electronic device control system of claim 1, wherein:
said electronic device includes display means (Col 9, line 65. Display on printer.); and
said electronic device includes control means which confirms the content of the operation data (Col 20-24. Notifies of print job in queue.), judges whether or not said electronic device has function means for performing a selected function required to perform an operation based on the operation data (Col 9, lines 57-59; Col 10, lines 17-19. Verifies print data to print or not.), then indicates the judgment result on said display means (Col 9, lines 65-66. Displays notification.).

23. As per claim 10, Mazzagatte teaches the electronic device control system of claim 1, wherein:
said portable data storage means also stores user management identification data (Col 8, lines 20-37. Smart card contains identification information such as name, organization, and other information.), and transmits user management identification data on said electronic device (Col 9, lines 53-58. Printer reads and verifies the identification information.); and
said electronic device controls to limit the performance of an operation of said electronic device based on the user management identification data received from said portable data storage means (Col 9, lines 60-64. If identification information is verified, printer proceeds with printout process. If not, notification is made of failure.).

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24. As per claim 12, Mazzagatte teaches the electronic device control system of claim 10, wherein:
the user management identification data includes data of at least one kind selected from the group consisting of department identification data identifying the department in which said data preparation means for preparing operation data is installed (Col 8, lines 27-30. Identification information includes organization unit.), user identification data set for each user (Col 8, lines 27-30. User's information.), and storage means identification data for each portable storage means (Col 8, lines 34-38. Smart card contains identification information.).

25. As per claim 14, Mazzagatte teaches the electronic device control system of claim 10 wherein:
the user management identification data is registered in said portable data storage means in advance (Col 8, lines 25-30, 33-37. Smart card contains identification information including user information data.).

26. As per claim 16, Mazzagatte teaches the electronic device control system of claim 1, wherein:
said electronic device is an image output device (Col 9, lines 57-58. Printer.), and the operation data is print data (Col 9, lines 9. Print data.).

27. As per claim 18, Mazzagatte teaches the electronic device control system of claim 1, wherein:
said data preparation means is a personal computer (Col 7, lines 46-47. Desktop computer.).

28. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mazzagatte and Francis, in view of Peters, US Patent #6,601,093 (Peters hereinafter).

29. As per claim 20, Mazzagatte teaches that the portable data storage may be a smart card (Col 8, lines 33-34). However, Mazzagatte does not specifically teach the electronic device control system of claim 1, wherein: said portable data storage means includes at least one element selected from the group

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consisting of a portable phone; and a portable information processing terminal. Peters teaches of a wireless device such as a wireless notebook computer transmitting information to a printer (Col 4, lines 36-50).

30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Mazzagatte, Francis, and Peters to include a wireless device such as a portable terminal and a portable phone to transmit information to a printer because doing so would improve the system of Mazzagatte and Francis by providing different types of mobile devices that clients can use for secure printing, which would increase the field of use of the system.

Claim Rejections - 35 USC § 102

31. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

32. Claim 26 is rejected under 35 U.S.C. 102(e) as being anticipated by Mazzagatte.

33. As per claim 26, Mazzagatte teaches the invention as claimed including an apparatus for receiving print data and identification data, where printing is based on matching of identification information, Mazzagatte's teachings comprising:

an operation data receiving section for receiving operation data from a data preparation device which prepares the operation data and identification data that uniquely identifies the operation data (Col 7, lines 46-48; Col 8, lines 19-23, 58-63; Col 9, lines 8-10. Computer transmits print data along with identification data to printer.);

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an identification data receiving section for receiving the identification data transmitted automatically from a portable storage device when the portable data storage means approaches said electronic device (Col 9, lines 56-59. Upon presenting the smart-card to the printer, printer verifies the unique identification information.), the identification data receiving section having a function to store the identification data received from said data preparation device (Col 9, lines 52-55. Verifies identification information from smart card. Col 10, lines 15-19. Use identification information from the smart card to identify Identification information stored in print queue.); and

an operation section for performing an operation based on the operation data which is received by said operation receiving section and is uniquely identified by the identification data received by said identification data receiving section (Col 9, lines 61-62; Col 10, lines 15-19. Printer identifies print jobs based on the identification data of the smart card and proceeds with printout process.).

Conclusion

34. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained

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from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see [http://pair-](http://pair-direct.uspto.gov)

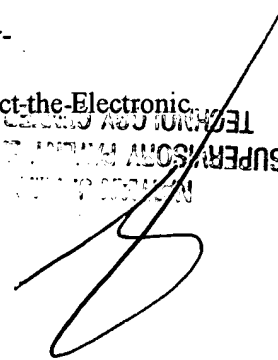
[direct.uspto.gov](http://pair-direct.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

October 30, 2006

JJ

TECHNICAL
SUPERVISOR
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A large, stylized handwritten signature in black ink, slanted upwards from left to right, crossing over the stamp.